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MAILED
JUL 06 2011
OFFICE OF PETITIONS

In re Patent No. 7,909,848 : DECISION ON REQUEST FOR
Issued: March 22, 2011 : RECONSIDERATION OF PATENT
Application No. 10/777,019 : TERM ADJUSTMENT AND
Filed: February 11, 2004 : NOTICE OF INTENT TO ISSUE
Attorney Docket No. 101896-234: CERTIFICATE OF CORRECTION
(DEP5100CIP) :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d) AFTER PATENT ISSUANCE" filed May 20, 2011, and on the "COMMUNICATION REGARDING PATENT TERM ADJUSTMENT", filed December 14, 2010, which are being treated as a petition under 37 CFR 1.705(d). Patentees request that the revised patent term adjustment for the above-identified patent be set at one thousand two hundred sixty-two (1262) days.

The request for reconsideration of the patent term adjustment indicated in the patent is GRANTED to the extent indicated.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of one thousand one hundred forty-six (1146) days.

On March 22, 2011, Application No. 10/777,019 matured into Patent No. 7,909,848. Patentees timely filed the present request for reconsideration within two (2) months of the date the patent issued. See 37 CFR 1.705(d).

First, patentees dispute the reduction of 99 days associated with the filing of a "miscellaneous incoming letter" received in the Office on December 14, 2010. Patentees asserts that the paper filed on December 14, 2010, was a "Patent Term Adjustment disclosure letter" advising the USPTO that patentees were accorded 57 days of patent term for which they were not entitled. Patentees argue that this disclosure letter is not a basis for patent term reduction, and thus, the 99 days of applicant delay pursuant to 37 CFR 1.704(c)(10) is not warranted.

The Office concurs with patentees' assertion. A review of the application record confirms that no paper aside from the "COMMUNICATION REGARDING PATENT TERM ADJUSTMENT" was filed after the mailing of the notice of allowance. A request for reconsideration of the patent term adjustment indicated in the notice of allowance pursuant to 37 CFR 1.705(b) is not a paper for which its filing is considered a "failure to engage in reasonable efforts" within the meaning of 37 CFR 1.704(c)(10). Thus, it is concluded that the reduction of 99 days is not warranted and will be removed.

Second, patentees assert that the Office should have assessed a period of reduction for applicant delay pursuant to 37 CFR 1.704(c)(7) for submitting a reply having an omission. Patentees indicate that the period of adjustment should be reduced by 83 days, beginning on the day after the date the reply having the omission was filed, July 27, 2007, and ending on the date the reply correcting the omission was filed, October 17, 2007. The Office agrees with patentees' assertion. Accordingly, a period of reduction of 83 days will be entered.

Third, patentees argue:

A final office Action was mailed February 8, 2008, and an Amendment and Response to the final Office Action was filed on March 13, 2008. In the Advisory Action mailed April 4, 2008, the amendment after final was not entered. A Notice of Appeal was filed April 18, 2008, and after a pre-appeal conference, the Examiner withdrew the final Office Action. A new, non-final Office Action was mailed on August 11, 2008. Since the final Office Action mailed February 8, 2008 was withdrawn, the USPTO should have mailed an Office Action no later than February 17, 2008,

four months after the response filed on October 17, 2007. The Office Action was not mailed until August 11, 2008, 176 days late. The PTA was increased to account for a USPTO delay of 29 days, thus the PTA should be increased by an additional 147 days, for a total of 176 days to account for this delay by the USPTO.

Petition, 12/14/10, p. 2.

Initially, the Office notes that the final Office action mailed February 8, 2008, was "withdrawn", not "vacated." However, in essence, patentees argue that the final Office action of February 8, 2008, was "vacated", and as such the Office action of February 8, 2008, should be treated as not having been issued for purposes of determining whether the issuance of the patent was delayed due to the failure of the USPTO to respond to applicants' reply of October 17, 2007, within four months after the date on which the reply was filed. Patentees' arguments have been considered but are not persuasive.

The vacatur of an Office action sets aside or withdraws any rejection, objection or requirement in an Office action, as well as the requirement that the applicant timely reply to the Office action to avoid abandonment under 35 U.S.C. § 133. The vacatur of an Office action signifies that the Office action has been set aside, voided, or withdrawn as of the date of the vacating Office action or notice. The vacatur of an Office action, however, does not signify that the vacated Office action is void *ab initio* and is to be treated as if the USPTO had never issued the Office action. The patent examination process provided for in 35 U.S.C. §§ 131 and 132 contemplates that Office actions containing rejections, objections or requirements will be issued, and that the applicant will respond to these Office action, "with or without amendment." (35 U.S.C. § 132(a)). The mere fact that an examiner or other USPTO employee upon further reflection determines that an Office action, or that a rejection, objection or requirement in an Office action, is not correct and must be removed does not warrant treating the Office action as void *ab initio* and as if the USPTO had never issued the Office action.

The USPTO appreciates that there may be situations in which it is appropriate to treat an Office action or notice issued in an application as void *ab initio* and as if the USPTO had never

issued the Office action. However, these would be extremely rare situations, such as the issuance of an Office action or notice by an employee who does not have the authority to issue that type of Office action or notice, the issuance of an Office action or notice in the wrong application, or the issuance of an Office action or notice containing language not appropriate for inclusion in an official document. In essence, the situations in which it is appropriate to treat an Office action or notice issued in an application as void *ab initio* and as if the USPTO had never issued the Office action are the situations in which it is appropriate to expunge an Office action or notice from the USPTO's record of the application. That is simply **not** the case in this situation.

Pursuant to 35 U.S.C. § 154(b)(1)(A)(ii), patentees are entitled to day-to-day adjustment if the USPTO delays the issuance of a patent by failing to respond to a reply by the applicant within four months from the filing of the reply. The record of the above-identified patent indisputably indicates that the USPTO entered an Office action under 35 U.S.C. § 132, specifically a final Office action, on February 8, 2008, within four months of the filing of a reply on October 17, 2007. The fact that the Office later withdrew the final Office action of February 8, 2008, does not negate the fact that the Office responded within the meaning of 35 U.S.C. § 154(b)(1)(A)(ii) and 37 CFR 1.702(a)(2) on February 8, 2008, to the reply filed on October 17, 2007. Unless expunged from the record (which is not warranted in this situation), for purposes of calculating patent term adjustment, the Office action entered by the examiner on February 8, 2008, was properly used to determine whether the USPTO delayed the issuance of the above-identified patent by failing to respond to the reply of October 17, 2007, within four months from the filing of the reply under of 35 U.S.C. § 154(b)(1)(A)(ii) and 37 CFR 1.702(a)(2). See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term*, 65 Fed. Reg. 54366 (Sept. 18, 2000) (final rule). Accordingly, no period of adjustment will be entered.

Fourth, patentees assert that the Office should have assessed a period of reduction of 121 days for applicant delay pursuant to 37 CFR 1.704(c)(8) for filing an Information Disclosure Statement on February 17, 2010 after the filing of a Request for Continued Examination on October 19, 2009. The Office concurs. The record does not support a conclusion that the examiner

expressly requested the IDS. Further, a review of the IDS, filed February 17, 2010, reveals that applicants did not include a proper statement under 37 CFR 1.704(d). Accordingly, a period of reduction of 121 days will be entered.

In view thereof, the patent term adjustment indicated in the patent is **one thousand one hundred forty-six (1146) days**.

The Office will charge the \$200.00 fee set forth in 37 CFR 1.18(e) as authorized.

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **1146 days**.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosures: Copy of DRAFT Certificate of Correction and Copy of PALM screen

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,909,848 B2

DATED : Mar. 22, 2011

INVENTOR(S) : Patel et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (1251) days.

Delete the phrase "by 1251 days" and insert -- by 1146 days--

10/777,019	TISSUE RETRACTOR AND GUIDE DEVICE	101896-234 (DEP5100CIP)	06-29-2011::13:48:48
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Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/777,019

Filing or 371(c) Date:	02-11-2004	Overlapping Days Between {A and B} or {A and C}:	32
Issue Date of Patent:	03-22-2011	Non-Overlapping USPTO Delays:	1525
A Delays:	693	PTO Manual Adjustments:	-105
B Delays:	864	Applicant Delays:	274
C Delays:	0	Total PTA Adjustments:	1146

Patent Term Adjustment History Explanation Of Calculations

Number	Date	Contents Description	PTO (Days)	APPL (Days)	Start
136	06-29-2011	Adjustment of PTA Calculation by PTO		121	0
135	06-29-2011	Adjustment of PTA Calculation by PTO		83	0
134	06-29-2011	Adjustment of PTA Calculation by PTO	99		0
128.5	10-18-2009	PTA 36 Months	864		0.5
128	03-22-2011	Patent Issue Date Used in PTA Calculation			0
127	02-21-2011	Export to Final Data Capture			0
126	02-18-2011	Dispatch to FDC			0
125	02-18-2011	Dispatch to FDC			0
124	12-14-2010	Miscellaneous Incoming Letter	99		0
122	12-20-2010	Application Is Considered Ready for Issue			0
121	12-15-2010	Issue Fee Payment Verified			0
120	12-15-2010	Issue Fee Payment Received			0
119	10-29-2010	Finished Initial Data Capture			0
118	10-22-2010	Email Notification			0
117	10-22-2010	Mail Examiner Interview Summary (PTOL - 413)			0
115	09-17-2010	Export to Initial Data Capture			0
112	09-16-2010	Mail Notice of Allowance			0
111	09-13-2010	Issue Revision Completed			0

110	08-16-2010	Information Disclosure Statement considered	0
109	08-30-2010	Document Verification	0
108	08-30-2010	Notice of Allowance Data Verification Completed	0
107	08-30-2010	Case Docketed to Examiner in GAU	0
106	08-16-2010	Electronic Information Disclosure Statement	80 100
105	08-16-2010	Information Disclosure Statement (IDS) Filed	0
104	08-16-2010	Allowability Notice	0
103	06-12-2010	Paralegal TD Accepted	0
102	05-28-2010	Terminal Disclaimer Filed	0
101	06-03-2010	Date Forwarded to Examiner	0
100	05-28-2010	Response after Non-Final Action	0
99	02-17-2010	Reference capture on IDS	0
98	02-17-2010	Information Disclosure Statement (IDS) Filed	0
97	03-04-2010	Electronic Review	0
96	03-04-2010	Email Notification	0
95	03-04-2010	Mail Non-Final Rejection	13 85
94	03-01-2010	Non-Final Rejection	0
91	02-17-2010	Information Disclosure Statement considered	0
90	02-17-2010	Information Disclosure Statement (IDS) Filed	0
89	08-03-2009	Electronic Information Disclosure Statement	94 70
88	10-22-2009	Date Forwarded to Examiner	0
87	10-19-2009	Amendment Submitted/Entered with Filing of CPA/RCE	0
86	10-22-2009	Date Forwarded to Examiner	0
85	10-19-2009	Request for Continued Examination (RCE)	0
84	10-22-2009	Disposal for a RCE / CPA / R129	0

83	10-19-2009	Workflow - Request for RCE - Begin	0	
82	10-09-2009	Email Notification	0	
81	10-09-2009	Mail Examiner Interview Summary (PTOL - 413)	0	
80	10-05-2009	Examiner Interview Summary Record (PTOL - 413)	0	
79	09-04-2009	Electronic Review	0	
78	09-04-2009	Email Notification	0	
77	09-04-2009	Mail Final Rejection (PTOL - 326)	3	70
76	08-31-2009	Final Rejection	0	
75	08-03-2009	Information Disclosure Statement considered	0	
74	07-31-2009	Information Disclosure Statement considered	0	
73	08-03-2009	Information Disclosure Statement (IDS) Filed	0	
72	07-31-2009	Information Disclosure Statement (IDS) Filed	0	
71	06-16-2009	Date Forwarded to Examiner	0	
70	05-01-2009	Response after Non-Final Action	0	
69	05-04-2009	Email Notification	0	
68	05-04-2009	Mail Examiner Interview Summary (PTOL - 413)	0	
67	04-28-2009	Examiner Interview Summary Record (PTOL - 413)	0	
65	02-20-2009	Electronic Review	0	
64	02-20-2009	Email Notification	0	
63	02-20-2009	Mail Non-Final Rejection	0	
62	02-17-2009	Non-Final Rejection	0	
61	11-12-2008	New or Additional Drawing Filed	0	
60	12-03-2008	Date Forwarded to Examiner	0	
59	11-12-2008	Response after Non-Final Action	1	56
58	08-11-	Electronic Review	0	

	2008			
57	08-11-2008	Email Notification		0
56	08-11-2008	Mail Non-Final Rejection	29	46
55	08-04-2008	Non-Final Rejection		0
54	05-21-2008	Date Forwarded to Examiner		0
53	05-21-2008	Mail Appeals conf. Reopen Prosec.		0
52	05-20-2008	Pre-Appeals Conference Decision - Reopen Prosecution		0
51	04-18-2008	Request for Pre-Appeal Conference Filed		0
50	04-18-2008	Notice of Appeal Filed		0
49	04-04-2008	Email Notification		0
48	04-04-2008	Mail Advisory Action (PTOL - 303)		0
47	03-31-2008	Advisory Action (PTOL-303)		0
46	03-13-2008	Amendment after Final Rejection		0
45	03-18-2008	Date Forwarded to Examiner		0
44	03-13-2008	Amendment after Final Rejection		0
43	02-12-2008	Electronic Review		0
42	02-09-2008	Email Notification		0
41	02-08-2008	Mail Final Rejection (PTOL - 326)		0
40	02-04-2008	Final Rejection		0
39	10-08-2004	Information Disclosure Statement considered		0
38	10-08-2004	Information Disclosure Statement (IDS) Filed		0
37	10-20-2007	Email Notification		0
36	10-19-2007	PG-Pub Issue Notification		0
35	10-18-2007	Date Forwarded to Examiner		0
34	10-17-2007	Response after Non-Final Action		0

33	10-17-2007	Electronic Review	0
32	10-16-2007	Email Notification	0
31	10-15-2007	Mail Miscellaneous Communication to Applicant	0
30	10-10-2007	Miscellaneous Action with SSP	0
29	07-30-2007	Date Forwarded to Examiner	0
28	07-26-2007	Response after Non-Final Action	0
27	05-07-2007	Mail Non-Final Rejection	0
26	04-30-2007	Non-Final Rejection	0
25	02-21-2007	Date Forwarded to Examiner	0
24	02-15-2007	Response to Election / Restriction Filed	0
23	01-19-2007	Mail Restriction Requirement	648 0.5
22	01-08-2007	Restriction/Election Requirement	0
21	10-12-2005	Case Docketed to Examiner in GAU	0
19	09-17-2004	Reference capture on IDS	0
18.7	09-17-2004	Information Disclosure Statement (IDS) Filed	0
18	09-17-2004	Information Disclosure Statement (IDS) Filed	0
17	05-07-2004	Reference capture on IDS	0
16.7	05-07-2004	Information Disclosure Statement (IDS) Filed	0
16	05-07-2004	Information Disclosure Statement (IDS) Filed	0
15	10-08-2004	Reference capture on IDS	0
14.7	10-08-2004	Information Disclosure Statement (IDS) Filed	0
14	10-08-2004	Information Disclosure Statement (IDS) Filed	0
13	02-18-2005	IFW TSS Processing by Tech Center Complete	0
12	02-18-2005	Case Docketed to Examiner in GAU	0
11	08-05-2004	Application Return from OIPE	0

10	08-05-2004	Application Return TO OIPE	0
9	08-05-2004	Application Dispatched from OIPE	0
8	08-06-2004	Application Is Now Complete	0
7	07-08-2004	Payment of additional filing fee/Preexam	0
6	07-08-2004	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	0
5	05-10-2004	Notice Mailed--Application Incomplete--Filing Date Assigned	0
4	03-19-2004	Cleared by OIPE CSR	0
3	03-19-2004	CASE CLASSIFIED BY OIPE	0
2	03-06-2004	IFW Scan & PACR Auto Security Review	0
1	02-11-2004	Initial Exam Team nn	0
0.5	02-11-2004	Filing date	0

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